

REMARKS / ARGUMENTS

Attached hereto is a marked-up Appendix version of the changes made to the title by the current amendment. The attached pages are captioned: “Appendix: Version with Markings to Show Changes Made”.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
Johnson & Johnson

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## Appendix: Version with Markings to Show Changes Made

### In The Title

## Methods and Devices for Defining and Marking Tissue



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REMARKS

Claims 50-78 have been added. Claims 46-78 are pending the application. Claims 46-48 are rejected as anticipated. Claim 49 is rejected as obvious.

Information Disclosure Statement:

An information disclosure statement and form PTO-1449 were submitted with the preliminary amendment in the filing papers of this continuation application. However, the Examiner did not return a copy of the form PTO 1449 with references initialed. The Examiner is respectfully requested to return an initialed copy of the form PTO-1449 with the next Office Action. A copy of the form PTO 1449 is enclosed with this response for the Examiner's convenience.

Added Claims:

Support for added Claims 50-78 is found in the application as filed, including the drawings and claims, including without limitation Imaging systems disclosed at Page 6, lines 18-25, Page 14, lines 4-10, page 3, lines 12-15, page 22, lines 2-6; non-metallic materials, calcium carbonate, biodegradable polymers disclosed at pages 22, line 7 to page 23, line 6. No new matter is added.

102 Rejection:

Claims 46-49 are rejected as being anticipated under 102(e) by Yoon et al. '167. It is believed the Examiner refers to US 5,445,167. The Examiner is requested to notify Applicant if that is not the case.

It is respectfully urged that this rejection is improper because Yoon et al. '167 does not teach each and every claim limitation of the rejected claims.

With respect to Claim 46, it is respectfully urged that Yoon et al. '167 does not teach

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or suggest: marking a particular tissue area to identify that particular tissue area for a later diagnostic or therapeutic procedure, at least one discrete marker element, or ejecting a marker element into tissue to be marked. Instead, Yoon et al. '167 appears to be directed to applying surgical clips to a body, rather than to marking a tissue area.

With respect to Claim 47, it is respectfully urged that Yoon et al. '167 does not teach or suggest depositing a marker element within tissue, or a plurality of marker elements disposed within a lumen.

With respect to Claim 48, it is respectfully urged that Yoon et al. '167 does not disclose depositing a marker element in tissue, or positioning a marker element applier adjacent a region of tissue to be marked.

The Examiner supports the rejection by stating that Yoon et al. '167 shows an introducer having a "closed distal end (208)", a "tube (206) an axial opening (178)" a "side exit 210", a "proximal opening (178)", "marker elements (48)", and a "shaft applying compressive forces (188)". It is respectfully urged that the Examiner has misinterpreted Yoon et al. '167. Yoon et al. '167 discloses a modified suture tie device 48 (column 8, lines 4-5), a cap 178 (column 17, line 10), and spring 188 (column 16, lines 59-62. ). Yoon et al. also discloses a rod 180 passing through an opening in cap 178, with a pusher member 184 (bottom of column 14, top of column 15). If the Examiner's position is that the suture tie device 48 is the equivalent of a marker as recited in Claims 46-48, the Examiner is respectfully requested to provide support for this position.

### 103 Rejection:

The Examiner rejects Claim 49 as obvious over Yoon et al. '167 alone. It is respectfully urged this rejection is improper for the following reasons.

The Examiner's explanation for this rejection is:

"Yoon shows all the structural, functional, and method limitations of the invention as set forth in the previous paragraphs of this office action, but does not explicitly state moving the device to a second position. It is obvious to one of ordinary skill in the art to move the device in



order to suit various needs and applications; it is implicitly inherent that the device must be moved when multiple marker elements are used because multiple markers cannot be used in the identical areas." (italics added)

It is respectfully urged that this rejection is faulty because (1) it is based on a faulty assumption, and (2) the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

First, the rejection is faulty because, as explained above under the 102 rejections, Yoon et al. does not show each and every structural, functional, and method limitation of the invention.

Second, even if one somehow construed Yoon et al. as teaching all the limitations as the Examiner maintains, the rejection would still be improper because the Examiner has not shown the suggestion or motivation in the prior art to modify Yoon et al. to obtain the invention of Claim 49. In particular, because, Yoon et al. does not teach or suggest marking tissue for later locating/identifying the marked site. Instead, Yoon et al. teaches suturing body tissue. The element noted by reference number 48 in Yoon et al. is a "modified suture tie device 48" as disclosed at column 8, lines 4-6 of Yoon et al.

It is respectfully urged that Yoon et al. does not teach or suggest a method of marking a biopsy site. For that reason, it is respectfully urged that the Examiner's rejection is no more than improper hindsight reliance on the Applicant's own disclosure to reconstruct the Applicant's invention, and is not based on motivation provided by the prior art.

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**Conclusion:**

The Examiner is respectfully requested to reconsider the application as amended and to allow the claims in the next office action. Should the Examiner have any questions, the Examiner is requested to contact the undersigned at the number below.

Respectfully submitted,

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